(192)

FILED
SEP 23 1941
CHARLES ELMORE CROPLEY
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

Nos. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

REPLY BRIEF OF PETITIONER.

PAUL CARPENTER,
HAROLD J. KINNEY,
Counsel for Petitioner.

INDEX.

PAGE

Introductory Remarks 1

Questions Involved 2

(a) The reasonable doubt doctrine..... 3

(b) Scope of Appellate review..... 4

(c) Weight to be given allowed claims in measuring the patentability of rejected claims..... 5

Inaccuracies in Respondent's Brief and Comments Regarding Same 6

Conclusions 11

Table of Cases Cited.

Abbott v. *Coe*, 109 F.(2d) 449, 452.....3, 10

Battery Patents Corp. v. *Coe*, 93 F.(2d) 220, 226-7.....3, 9

Cantrell v. *Wallick*, 117 U. S. 689..... 12

Carbide & Carbon Chemicals Corp. v. *Coe*, 102 F.(2d) 236, 241-2 .....10, 11

General Motor Corp. v. *Coe*, 120 F.(2d) 736.....1, 2

Gyro Process Co. v. *Coe*, 107 F.(2d) 195, 200..... 9

McCullough v. *Cosgrave*, 309 U. S. 634..... 11

Minnesota, etc. v. *Coe*, 118 F.(2d) 593, 594-5..... 4

Morgan v. *Daniels*, 153 U. S. 120..... 10

Mumm v. *Decker*, 301 U. S. 168, 171..... 12

Powers v. *Comm. of Internal Revenue*, 312 U. S. 259....10, 11

Radtke Patents Corp. v. *Coe*, 50 U.S.P.Q. 316;..... F.(2d) 4, 6

Robertson v. *Cooper*, 46 F.(2d) 766, 769..... 9

Constitution, Article I, Section 8, Clause 8..... 12

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

Nos. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

REPLY BRIEF OF PETITIONER.

This is in reply to the brief for the respondent filed in August, 1941, in the above matter.

Introductory Remarks.

It is understood that a Petition for a Writ of Certiorari is about to be filed, or else has been filed, in *General Motors Corp.* v. *Coe*, 120 F. (2d) 736; 50 U.S.P.Q. 10 (Ct. App., D.C., June 16, 1941) on the same basic question here involved, *i. e.*, the reasonable doubt doctrine. The *General Motors* v. *Coe* decision has been cited and briefly discussed (Pet. 10). In that decision the United States Court of Appeals for the District of Columbia relied solely upon its earlier decision in the present case as authority in

respect to resolving doubts against the inventor on the question of "invention."

If the respective Writs of Certiorari are granted, as requested, it seems that this case and *General Motors* v. *Coe* might conveniently be heard on the same day and decided concurrently.

* * * * *

In the respondent's brief there are certain omissions and certain statements to which the petitioner believes it necessary, for the proper consideration of its petition, to call attention. Also it is desired to point out a decision of the court below, published since this petition was filed, which pertinently bears on one of the questions herein.

Questions Involved.

Three questions are presented in the petition which mainly involve:

(*a*) resolving reasonable doubt in determining invention;

(*b*) scope of appellate review; and

(*c*) the weight to be given allowed claims in measuring the patentability of similar or analogous rejected claims.

The reasonable doubt doctrine is most broadly involved in question 1 (page 6 of the Petition) and is somewhat more narrowly involved in questions 2 and 3; the weight to be given to allowed claims in measuring the patentability of analogous rejected claims is involved only in questions 2 and 3 (pages 6 and 7 of the Petition); while the scope of appellate review is, of course, involved in all three questions.

(a) The reasonable doubt doctrine.

In the majority opinion of the court below (R. 309; 118 F. (2d) 593, 594), it was stated that:

> "Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously not law in relation to appeals from the District Court."

In the Petition the question concerning whether the above pronouncement is to become law is presented as the petitioner's first question. On page 11 of the Petition it is stated that the above pronouncement is opposed to upwards of fifty decisions and that *there is no precedent whatsoever in support of it*. This statement is not challenged by the respondent.

In the respondent's brief, however, this question is *omitted*. The respondent (page 2 of his brief) lists the questions that are presented in the Petition as being only two in number. He excludes the reasonable doubt question, which is the basic question. Furthermore, he omits all discussion of the reasonable doubt doctrine.

The doctrine of resolving reasonable or real doubts in favor of patent applicants has long existed, like many other principles of law, side by side in the body of the law with the entirely separate and distinct principle, *viz.*, the initial presumption of appellate courts that the *fact* findings of trial courts *and* administrative tribunals are correct; *cf.* last paragraph in *Abbott* v. *Coe*, 109 F. (2d) 449, at 452 (Ct. App., D.C., Nov. 1939), cited by respondent.

Respondent's assertion (page 8 of his brief) that the cases cited by Petitioner (Pet. 11) "all involved a direct appeal from the Patent Office" is erroneous, as discussed more in detail hereinbelow; but see, for example, *Battery*

Patents Corp. v. *Coe,* 93 F. (2d) 220, at 226-7 (Pet. 11), which is an appeal from the District Court in a R.S. 4915 action.

(b) Scope of appellate review.

In the present case (118 F. (2d) 593), and in its later decision in *General Motors Corp.* v. *Coe,* 120 F. (2d) 736, *supra,* the court below refuses to disturb a decision on appeal if there is a *rational basis* therefor; see *Abbott* v. *Coe,* 109 F. (2d) 449, at 451 and 452 (Ct. App., D.C., 1939), cited by the Court of Appeals in its decision in the instant case and also in *General Motors Corp.* v. *Coe,* where the expression "rational basis" was introduced in respect to suits of this character.

In *Radtke Patents Corp.* v. *Coe,* 50 U.S.P.Q. 316; ..... F. (2d) ..... (decided June 30, 1941), which is an action under R.S. 4915, there is ample evidence in the opinion of a "rational basis" for the decision of the District Court and the Patent Office in favor of patentable invention (and this is corroborated by the dissent on the merits of one of the judges of the Court of Appeals), and yet the Court of Appeals reversed the District Court and held that the claims there in issue did not involve patentable invention. The Court, by a majority, stated (50 U.S.P.Q. 316, at 332, Col. 2):

> "As previously indicated, this Court cannot be guided by the assumption upon which the parties seem to have relied. Instead, it is required to determine the question of invention from the record."

This is a striking contrast to what the majority of a differently constituted Court said in the opinion in the instant causes (*Minnesota etc.* v. *Coe,* 118 F. (2d) 593, at 594-5) in respect to its power and duty, as a reviewing court: namely,

that it should not itself determine whether "invention" is or is not present.

This further shows an inconsistent and unsettled policy within the Court of Appeals itself as to the scope of appellate review *generally*, and in respect to suits under Section 4915 R.S. *particularly*. Scope of review goes to the very root of an appellate tribunal's chief function.

(c) Weight to be given allowed claims in measuring the patentability of rejected claims.

It was pointed out in the Petition that there is no disagreement as to the essential facts. One important fact is clearly summarized in the following concise admission of respondent (page 5 of his brief):

> "The Patent Office, however, granted subsequent claims of other persons which were substantially identical to the claims rejected in the instant case (R. 67, 95)."

It is a most anomalous situation if, with novelty and utility admitted by respondent (R. 308, lines 4-5) and with it further admitted (Brief, p. 5) that claims "substantially identical" to those here in issue were granted to others with later applications (R. 310), patent protection should be denied to Oakes and Bartling, the *first inventors*.

It is accordingly submitted that due weight should be given to claims of the issued Robie, Paulson and Hepp patents (which are of course presumptively valid) in measuring the patentability of claims here in issue which are admittedly "substantially identical," as well as admittedly defining novel, useful and advantageous articles of manufacture (R. 308). That the weight to be given to allowed claims in measuring the patentability of rejected claims is a question of law, and one which is unsettled in the court

below, is clear (Pet. 14). Oral arguments on this point of law will probably be heard by Court of Appeals (in other cases) during October or November, 1941.

How different would have been the conclusion of the court below in the present case if it followed the principle laid down by different judges of the same court in *Radtke Patents Corp.* v. *Coe, supra,* namely, that in an appeal from the District Court under Section 4915 R.S., the Court of Appeals, D.C., "is required to determine the question of invention from the record." In the present case (118 F. (2d) 593, at 594), contrariwise, the Court said, "we are to decide not whether in our opinion there was invention," etc.

Inaccuracies in Respondent's Brief and Comments Regarding Same.

(1) *Re page 1 of his brief:*—The memorandum opinions of the U. S. District Court, D.C., are reported at 28 F. Supp. 430 and 433. Petitioner overlooked pointing this out in its Petition.

(2) *Re footnote on page 3 of his brief:*—The counts of the Oakes v. Paulson Interference No. 78,175 appear as claims 1 and 2 of the Paulson patent (R. 303 B), and the counts of the Oakes v. Robie Interference No. 76,371 appear as claims 1 to 10 of the Robie patent (R. 98).

(3) *Re end of page 4 and top of page 5 of his brief:*—The respondent asserts that applications here in issue were rejected by the Patent Office "because the use of vinyl resins in making abrasives was *taught* by combining prior art." No place did the Patent Office make any contention that such was "*taught.*" On the contrary *the Commissioner has expressly admitted novelty* (R. 308) as before stated. The position of the Board of Appeals in the three applications here involved is shown at the pages pointed out

by respondent (R. 63, 210 and 276) but do not support respondent's assertion. *The third paragraph on page 66 of the Record well sums up the Board's position,* and it simply tends to confuse settled issues to argue at this stage that admittedly novel articles are "taught" by disclosures fully considered prior to such admission.

It is further to be borne in mind that the Board did not have before it the pertinent new evidence in the present record which, *inter alia,* gave rise to the holding by the District Court that two of the claims there in issue involved patentable invention (R. 90). Among other things the Board did not have before it: (1) evidence to support the conclusions of the Court of Appeals as to the meritorious nature of the invention now established as proper (R. 308, lines 4-7); nor (2) the existence of the Robie or Paulson Patents (R. 95 and 303 A); nor, indeed (3) the pendency and status of the Oakes v. Robie and Oakes v. Paulson Interferences, which, in fact, though orally argued before the Examiners of Interferences on April 16 and 17, 1941, have not yet been decided, as of this writing.—Perhaps the Examiners of Interferences are left somewhat confused by the decisions of the court below on claims which are admittedly "substantially identical" (Respondent's Brief, page 5, lines 2-5) with the counts there under consideration.

(4) *Re last half of page 5 of respondent's brief:*—The contention of respondent in respect to the disclosure of the Benner patent also tends to confuse settled issues of facts, and to confuse the Commissioner's admission of novelty, as just stated above. The subject matter here claimed is a flexible abrasive article of the coated abrasive type, *e. g.,* abrasive belts or so-called sandpaper. The Benner patent (R. 268) does not at all concern such an article and purports only to involve an improvement in molded abrasive articles or emery wheels (R. 270, line 103, and R. 271, line 106);

also see the opinion of the court below in this connection (R. 308, end). Neither does the word "vinyl" even appear in the Benner *et al.* patent in connection with Benner's dissimilar article, and the court below recognizes (R. 309) that "there is much chemical authority" contrary to the contention that the styrol or styrene of the Benner *et al.* patent is a vinyl compound. In all events, the Benner *et al.* patent did not teach that sandpaper could be improved by the use of vinyl resins in any connection, for it teaches nothing about sandpaper; neither does it teach that vinyl resins, as a class, are useful in any connection whatsoever, for it does not even mention the same.

(5) *Re footnote on page 7 of respondent's brief:*—Respondent states that "Petitioner does not deny that there was substantial evidence to support a finding of no invention." Firstly, the trial court made no finding of fact, nor conclusion of law that there was "no invention" in the Oakes claims in issue (R. 85-90); neither did the trial court make any *fact* finding of no invention as to the Bartling claims (R. 280). Secondly, petitioner filed motions in the trial court for additional findings and for judgment (R. 91) and urged both before the trial court and the Court of Appeals that it is inconsistent with precedents and repugnant to justice here to deny patent protection on the inventors' admittedly novel, useful and advantageous contribution (R. 308) while similar and presumptively valid claims remain outstanding in the Robie, Paulson and Hepp patents, issued upon later filed applications; *inter alia*, see Petition for Rehearing (R. 312), Petition for Leave to File Bill of Review in District Court (R. 322), etc. It is not seen how Petitioner could have more emphatically denied that there is any substantial basis for a finding of no invention. On the other hand, Petitioner has consistently urged that the contrary conclusion is proper.

(6) *Re last half of page 8 of his brief:*—The respondent states that the cases cited by Petitioner (Pet. 11-12) are not in point because, he alleges, they "all involved a direct appeal from the Patent Office." This is inaccurate, as briefly noted hereinabove. In fact footnote 5 at the end of page 9 of respondent's brief demonstrates the inaccuracy of his own assertion.

Three decisions are cited by Petitioner (Pet. 11) involving appeals in action under Section 4915 R.S., namely:

Battery Patents Corp. v. *Coe,* 93 F. (2d) 220, at 226 and 227;

Gyro Process Co. v. *Coe,* 107 F. (2d) 195, at 200;

and

Robertson v. *Cooper,* 46 F. (2d) 766, at 769.

For convenient reference the following quotation from *Battery Patents Corp.* v. *Coe, supra* (Pet. 11) is given:

> "We are aware that this court has said that in case of a serious doubt in the mind of the court after a careful review of the evidence, the doubt should be resolved in favor of the one seeking a patent. *Application of Drew,* 55 App. D. C. 291, 4 F. (2d) 958 (1925); *In re Glafcke,* 51 App. D. C. 204, 277 F. 603 (1922); *In re Davidson,* 56 App. D. C. 279, 12 F. (2d) 814 (1926). It has also said that where there are, as here, concurring decisions of the patent tribunals, the court should be convinced beyond a reasonable doubt before reversing them that if a patent had been granted the court would upon the same record sustain it under attack. We are not doubtful under either of these rules that the application in the instant case should have been granted.
>
> "The decree of the District Court is Reversed."

This appears to fully answer respondent's assertion that the cases cited in the Petition "all involved a direct appeal from the Patent Office."

Several other decisions in appeals under R.S. 4915 might be cited, and in this connection it is desired to call attention to *Carbide & Carbon Chemicals Corp. et al.* v. *Coe,* 102 F. (2d) 236, at 241 and 242. This decision is particularly pertinent for several reasons: (1) The judge who wrote the dissent in that case wrote the majority opinion in the present case, while the judge who wrote the majority opinion there (concurred in by the Chief Justice) indicated his dissent on the merits in the present case. (2) A patent application was there under consideration having a later filing date than the *effective* record dates of the applications here involved, and the Court considered some of the same prior art here relied upon. (3) The chemistry of the case was somewhat similar in that vinyl resins were discussed, although food packaging was there involved while abrasive belts or "sandpaper" is here involved. (4) The majority of the Court, itself, there went into the question of "invention," and was not content with only determining whether there was some mere "rational basis" for the trial court's conclusion of no invention.

Moreover it is not seen why decisions in direct appeals are not likewise pertinent on the point in question: see *Morgan* v. *Daniels,* 153 U. S. 120 (Pet. 11); even see the last sentence in the opinion in *Abbott* v. *Coe,* 109 F. (2d) 449, at 452 (cited by the respondent), which holds that the normal presumptions of correctness apply as well to "administrative" as to "judicial" tribunals. (The decision in *Abbott* v. *Coe* was written by the same Justice of the court below who wrote the majority opinion in the present case.)

CONCLUSIONS.

The Justices of the Court of Appeals, D.C., are in conflict among themselves on the scope of appellate review in patent cases, and the majority opinion of the court which decided the present cases is inconsistent with the principles of appellate review laid down by this Court in *Powers* v. *Comm. of Internal Revenue,* 312 U.S. 259 (Pet. 16 and 23). They are in conflict among themselves as to the scope of appellate review *particularly* in respect to R.S. 4915 actions (compare the majority and dissenting opinions in *Carbide & Carbon* v. *Coe, supra,* with the majority opinion of said court in the present cases). The action of the majority of the court below in the present cases therefore constitutes such a departure from the accepted and customary course of judicial proceedings as to call for an exercise of this Court's power of supervision: *McCullogh* v. *Cosgrave,* 309 U.S. 634. There is even greater need in the present case to clarify and settle the law than in *Powers* v. *Comm. of Internal Revenue, supra,* because here it is impossible for such a case as this ever to be heard in any jurisdiction other than the District of Columbia (Pet. 18).

The reasonable doubt doctrine, heretofore consistently followed *without exception* in respect to all phases of patent application prosecution, and now for the first time not followed by a majority of the three Justices of the court below who heard this case, is of great importance to our patent system. There are broad practical and basic considerations in favor of retaining it. One consideration is that the burden of proof placed upon an inventor who seeks a patent should not be increased beyond what is reasonable and practicable; to do so would tend to encourage the secreting of inventions (instead of their disclosure) and the consequent retarding of progress. Further, Article I,

Section 8, Clause 8 of the Constitution itself weighs in favor of the reasonable doubt doctrine; it provides that:

> "The Congress shall have the power:
> * * *
>
> "To *promote* the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

It is not believed that it would be consistent with the apparent purpose of the Constitution, *viz.*, to *promote* or *encourage* inventions, and especially the disclosure thereof, if doubts were to be resolved against the inventor. It is believed that this provision of the Constitution may be the basic consideration underlying the more than fifty decisions (Pet. 12) in which *the reasonable doubt doctrine has previously been consistently followed,* with no exception, *both in appeals in actions under R.S. 4915 and in straight appeals from the Patent Office.*

In the Petition (heading 5, page 12) it was stated that:

> "This Court has never squarely passed upon the question of resolving doubts in favor of 'invention' or 'patentability,' though some of this Court's decisions have been judicially characterized as 'in point' on the familiar rule that, where doubt exists as to 'invention,' it should be resolved in favor of the inventor."

This statement was intended to be limited solely to cases involving *applications* for patents, and must be so limited to be accurate. This Court, in the case of infringement suits, has repeatedly upheld and enforced the principle of resolving doubts in favor of the inventor: see *Mumm* v. *Decker,* 301 U. S. 168, at 171; 81 L. Ed. 983, at 985, which squarely rules on this point and cites many prior decisions of this Court in support of said principle, such as *Cantrell* v. *Wallick,* 117 U.S. 689.

The fundamental errors of the majority of the Court of Appeals, D.C., and the failure of that Court properly to function as an appellate tribunal having been demonstrated in the Petition by discussion of specific assignments of error, which discussion is here supplemented, and Petitioner also being entitled to decrees on the merits, Petitioner prays that the decision of the court below be reviewed and reversed, and that writs of certiorari be granted to that end.

Respectfully submitted,

PAUL CARPENTER,
HAROLD J. KINNEY,
Counsel for Petitioner.

September 19, 1941.